


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: C. Boyle, et al. Attorney Docket: 6006-107
Serial No.: 10/672,695 Examiner: Christopher Prone
Filed: 9/26/03 Art Unit: 3738
Title: IMPLANTABLE GRAFT AND METHODS OF MAKING SAME

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**REQUEST FOR RECONSIDERATION: AMENDMENT AND
RESPONSE TO FINAL OFFICE ACTION**

Dear Sir:

On September 8, 2006, Applicants submitted an Amendment and Response to Final Office Action in response to the Final Office Action mailed on August 18, 2006. Subsequently, the Examiner issued an Advisory Action indicating that the proposed amendment would not be entered because it would require a new search. Applicants respectfully disagree and accordingly submit a Request for Reconsideration: Amendment and Response to Final Office Action.

Applicants reference M.P.E.P. 714.3, which states:

The refusal to enter the proposed [after-final] amendment should not be arbitrary. The proposed [after-final] amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified... However, if the [after-final] proposed amendment raises the issue of new

matter, the examiner should identify the subject matter that would constitute new matter. If the proposed amendment presents new issues requiring further consideration and/or search, the examiner should provide an explanation as to the reasons why the proposed amendment raises new issues that would require further consideration and/or search... Examiners should indicate the status of each claim of record or proposed in the amendment, and which proposed claims would be entered on the filing of an appeal if filed in a separate paper. [Underlining added for emphasis added]¹

Applicants note that the Examiner has not provided a detailed explanation as to the reasons why the proposed amendment would require a new search. Applicants also note that the Examiner has failed to indicate which proposed claims would be entered on the filing of an appeal if filed in a separate paper. Moreover, Applicants submit that the proposed amendments (incorporating limitations of previously written dependent claims into independent claims and subsequently canceling these dependent claims), will simplify the issues on appeal.

In the Advisory Action, Continuation Note of Section 3, the Examiner indicated that “[t]he change of independent claims to include other dependent claims creates new combinations that were not searched before.” The dependent claims noted by the Examiner are not new claims. Thus, given that the Examiner has already conducted a search on these dependent claims, Applicants are confounded by the Examiner’s statement that a new search is required. The subject matter at issue should already have been considered by the Examiner during previous examination. Accordingly, no new searches should be required.

In addition, should the Examiner decide to maintain his rejection of the claims, Applicants request that the Examiner remove the finality of the present Final Office Action, and provide Applicants with a clearer explanation as to why the pending claims

¹ See also 37 C.F.R. §1.116 (b)(2) which states, “After a final rejection or other final action (§ 1.113) in an application ... [a]n amendment presenting rejected claims in better form for consideration on appeal may be admitted.”

were rejected, so that they can respond to the Examiner's rejection of these claims. More specifically, Applicants seek a clearer explanation as to where in the *Burmeister* reference or the *Wright* reference is there a suggestion of (1) a microporous metal thin film as recited in independent claims 1, 18 and 29, or (2) an affixation member as recited in independent claims 1 and 29. By omission of any clear explanation in the present Final Office Action, the Examiner has improperly, albeit inadvertently, denied the Applicants an opportunity to respond to the Examiner's rejection of those claims, under 35 U.S.C. §103(a), thus rendering the finality of the present Office Action premature.

As previously noted, Applicants submit this Request for Reconsideration: Amendment and Response to Final Office Action in response to the Advisory Action mailed on October 2, 2006 and the Final Office Action mailed on August 18, 2006.

Amendments to the Specification begin on page 4 of this paper.

Amendments to the Claims are reflected in the listing of claims which begins on page 8 of this paper.

Remarks begin on page 14 of this paper.